Remarks

The present response is to the Office Action mailed in the above-referenced case on December 4, 2002. Claims 1-4 and 17-22 are pending for examination. Claims 1-4, 17-20 and 22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Yuen et al. (5,488,409), hereinafter Yuen, in view of Houston (U.S. 6,477,312 B1), hereinafter Houston. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yuen in view of Houston, as applied to claim 18 and further in view of Ichinose (U.S. 4,612,569), hereinafter Ichinose.

Firstly, applicant believes the Examiner should deal with the apparatus claims directly and separately from the method claim, as the apparatus claim has significantly different limitations than the method claim. Apparatus claims recite various elements including the meaning and functions of those elements. The Examiner has stated in the instant Office Action that, regarding claim 1, the combination of Yuen and Houston discloses all the features of the instant invention as discussed for claim 18 except for providing a speaker system. The Examiner, in this case, clearly has not specifically addressed all of the physical apparatus limitations of applicant's claim 1. The PTO has upheld basic requirements of unpatentability in that it is not enough to require that the disclosures of prior art references teach or suggest all of the claimed elements, rather, as stated by the Federal Circuit, unpatentability requires the presence or suggestion in the references of each and every element of the claimed invention. Applicant believes to create a proper case of unpatentability, also the Examiner must identify all of the elements of the claim, determine their meaning in light of the specification, and identify corresponding elements disclosed or suggested in the references.

Applicant has again carefully studied the prior art references of Yuen and Ichinose presented in previous Office Actions, and the newly presented reference of Houston, and the Examiner's rejections and statements in the instant Office Action. In response, applicant herein amend claim 18 to more particularly and distinctly claim the subject matter of applicant's invention regarded as patentable. Applicant amends the language of claim 18 to specifically recite, in step (b), identifying a specific media portion within the specific time of the continuous-loop recording by inserting, in real time during the media presentation, a flag set marking the beginning and end of the identified media portion, and in step (e), initiating playback or media store of the flagged portion of media. Applicant accordingly herein cancels claim 20.

Applicant's claim 18 as amended now recites:

18. (Amended) A method for setting and initiating selective playback or permanent storage of stored audio or audio-visual media from a user-interface on a recording device coupled with a media presentation device comprising steps of:

(a) initiating sequential continuous-loop recording of a specific time period of the presented media;

(b) identifying a specific media portion within the specific time period of the continuous-loop recording by inserting, in real time during the media presentation, a flag set marking the beginning and end of the identified media portion;

(c) activating a flag-set indicia from a user interface on the recording device;

(d) activating a recover indicia from the user interface of step (c), the recover operation for retrieving the flagged media; and

(e) initiating playback or media store of the flagged portion of media.

Regarding claim 18, the Examiner states that Yuen discloses applicant's method for setting and initiating selective playback or permanent storage of stored audio or audio-visual media from a user-interface on a perpetual recording device coupled with a media presentation device comprising substantially all of the steps of applicant's claim, with the exception of the limitation added by applicant in the previous response filed September 25, 2002, of sequential continuous-loop recording of a specific time period. The Examiner relies on Houston for teaching the limitation, stating that Houston teaches and instant replay system having endless videotape for facilitating the search of a particular point of interest on a recorded videotape, and it would have been obvious at the time of the invention to incorporate endless videotape as taught by Houston into Yuen's system in order to reduce the time in searching for a particular point of interest on the recorded videotape.

Applicant respectfully points out to the Examiner that reducing the time in searching for a particular point of interest on a recorded videotape is not particular object of applicant's patentable subject matter. Applicant's specific limitations recited in step (b) of claim 18 as amended, of identifying a specific media portion within the specific time period of the continuous-loop recording by inserting, in real time during the media presentation, a flag set marking the beginning and end of the identified media portion, are key and patentable limitations, which are considered at the heart of applicant's invention. In some embodiments of applicant's invention an input is provided for such flagging of the beginning and end of a portion of media within the specific time period of the continuous-loop recording, that is, a user may identify a media portion within the continuous-loop recording by inserting the flag set into the continuous-loop recording, in real-time, during presentation of the recorded media. For example, if the user recognizes a musical number playing over the speakers of a radio, or a televised interview of

interest, or the like, that user would like to retain, the user may, by special input, such as a button or voice commands, cause the flag set to be placed in the recording, thereby marking the beginning and ending of the media portion of interest within the moving real-time window of the continuous-loop recording.

Applicant has thoroughly and carefully reviewed the prior art presented, and respectfully points out to the Examiner that there clearly is no teaching, motivation or suggestion in any of prior art references presented, for placing such a flag set into a continuous-recording for identifying a portion of media for playback or storing, as is now specifically recited in applicant's claim 18. Yuen teaches inserting marks either at the beginning or end of a program for faster tape searches and for calculating such as program length, spaces in the recording tape, and so on.

Applicant's invention teaches automatically making a sequential continuous-loop recording of an incoming data stream, and also teaches a user interface for inserting a flag-set into the recorded media, the flag-set searchable and usable as indicia for beginning a playback session of recorded media at a desired point in the continuous-loop recording sequence. As taught in applicant's specification the flag-set is inserted by the user to denote a specific time period within a program, while that same program is being recorded, and by activating the flag-set indicia, the user is enabled for viewing the recorded specific time period within the program during sequential continuous-loop recording of that program, or at a later time from storage.

Yuen teaches that a VISS mark is inserted at the end of one program, that mark becoming the beginning of another program. Applicant argues that Yuen does not teach inserting a flag-set marking a specific time period within a media presentation, as taught in applicant's invention and recited in claim 18 as amended, rather; Yuen simply marks the beginning or ending points of programs, denoting the start or end of program. Applicant therefore argues that identifying a

specific time period within a program using a flag set, in real time while the program is being recorded in a sequential continuous-loop manner, <u>for recording and viewing or storage of the specified fixed time period</u> within the program is clearly not anticipated by Yuen, and there would be no advantage or motivation for Yuen to do so.

Applicant therefore believes that claim 18 is clearly and unarguably patentable over Yuen in view of Houston, as the reference clearly fails to disclose all of the limitations of applicant's claim as amended. The Examiner has rejected applicant's apparatus claim 1 on the basis of the reasoning applied for the rejection of claim 18. Applicant therefore believes claim 1 is also clearly and patentable as argued above over the combined art, as claim 1 also contains the key and patentable limitations as argued above on behalf of claim 18 as amended.

The Examiner has rejected claim 21 as being unpatentable over Yuen in view of Houston, as applied to claim 18 and further in view of Ichinose. In view of applicant's above amendments to claim 18 and argument presented herein, claim 21 is then patentable on its own merits or at least as dependent from a patentable claim, as are claims 2-4, 17, 19, 20 and 22.

As all of the claims as amended and argued above have been clearly shown to be patentable over the prior art presented by the Examiner, applicant respectfully requests that the rejections be withdrawn, and that the case be passed quickly to issue. If any fees are due beyond fees paid with this amendment, authorization is made to deduct those fees from deposit account 50-0534. If any time extension is needed beyond any extension requested with this amendment, such extension is hereby requested.
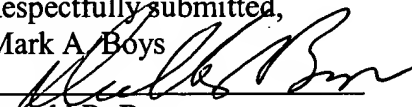
Version With Markings to Show Changes Made

In the claims:

18. (Amended) A method for setting and initiating selective playback or permanent storage of stored audio or audio-visual media from a user-interface on a recording device coupled with a media presentation device comprising steps of:

(a) initiating sequential continuous-loop recording of a specific time period of the presented media;

(b) identifying [the] a specific media [selection] portion within the specific time period of the continuous-loop recording by inserting, in real time during the media presentation, a flag set marking the beginning and end of the identified media portion;

(c) activating a flag-set indicia from a user interface on the recording device;

(d) activating a recover indicia from the user interface of step (c), the recover operation for retrieving the flagged media; and

(e) initiating playback or media store of the flagged portion of media.

Cancel claim 20.

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